

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#15/dpm  
2-24-04  
Pet re  
Restriction

APPLICANT: Ashby et al.  
SERIAL NO.: 09/843,496  
FILING DATE: April 25, 2001  
TITLE: EASY CUTTER  
EXAMINER: Druan, Thomas J.  
ART UNIT: 3724

**CERTIFICATE OF MAILING**

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**Petition From Requirement For Restriction**  
**Under 37 C.F.R. §1.144**

Adjustment date: 06/22/2004 EEKUBAY1  
02/11/2004 DTESSEM1 00000032 09843496  
01 FC:1460 -130.00-OP

Dear Sir:

This is a petition to withdraw the improper restriction requirement imposed by Examiner  
Thomas Druan.

**Facts**

By Office Action dated May 7, 2003, Examiner Thomas Druan imposed a restriction  
requirement to four groups of claims: "Group I: Claims 1-17 drawn to a cutter, card, and foam,  
classified in class 604, subclass 11; Group II: Claims 18-20 and 25-26, drawn to a cutter and  
foam, classified in class 604, subclass 369; Group III: Claims 21-22, drawn to a cutter and card,

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classified in class 606, subclass 174; and Group IV: Claims 23-24, drawn to a method of cutting foam, classified in class 83, subclass 13".

On June 6, 2003, Applicant responded by electing Group I claims.

In the same Office Action, Examiner Thomas Druan imposed a restriction to 2 species:

"Species A as in Figure 4" and "Species B as in Figure 8" and stated:

"Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, some claims may be generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election"

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention."

On June 6, 2003, Applicant responded, as required under M.P.E.P. §818.03(b)<sup>1</sup>, by electing Species A, with traverse, and requesting the Examiner to provide reasons for the restriction. Applicant further stated, among other reasons, that 37 U.S.C. 1.141<sup>2</sup> provides that a

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<sup>1</sup> M.P.E.P. §818.03(b): "A provisional election must be made even though the requirement is traversed."

<sup>2</sup> MPEP §806.04(a)

reasonable number of species may still be claimed in one application and since the legal threshold for the restriction was not met, the restriction was improper.

By Office Action dated September 2, 2003, Examiner Druan stated that the:

“required species election was not between claims 1 and 11, but between “Species A as in Figure 4” and “Species B as in Figure 8.” The examples in support of the restriction requirement are the species depicted in Figures 4 and 8, and as a picture is worth a thousand words, the examiner submits that there is enough information in those two figures to distinguish differences between them. In fewer than a thousand words, at least some differences are that the device of Figure 4 comprises a base with an opening and a flap with the perimeter of the flap defining a cutting edge which cooperates with the opening to perform a cutting action resulting in a single cut product, making the flap a cutting element; however, Figure 8 portrays a device that has a base with several openings and a flap having several depending structures wherein the depending structures mate with the openings to perform a cut resulting in several cut products, with the flap acting as a driving member to simultaneously actuate the depending structures which are each cutting elements. Therefore, the design, function, and effects of the two devices are unconnected. Lastly, 37 CFR 1.141 permits the allowance of more a reasonable number of species given that there is an allowable claim generic to all the claimed species. This does not preclude a restriction requirement between the species, but allows the examiner to rejoin non-elected species that may depend from an allowed generic claim.

The requirement is still deemed proper and is therefore made FINAL.

Since the election of Species A was not accompanied by a listing of all claims readable thereon as required by MPEP §809.02(a), the examiner has chosen claims 1-5, 10-13, and 17 to be readable on Species A.”

### Legal Analysis

The “restriction requirement” imposed by Examiner Druan is improper for at least the following reasons:

- 1) In Applicant’s response dated February 2, 2004, Applicant cancelled claims 1-10 and 13.

As such, there is only 1 independent claim pending in the case, which Examiner Druan has

restricted into 2 species. Since 35 U.S.C. §121 “Divisional Applications” precludes two patents from having the same claims, this “restriction requirement” on its face constitutes a denial of Applicants’ constitutional and statutory right under 35 U.S.C. §101<sup>3</sup> to patent its invention(s) and an unlawful taking by the government of a number of these “species”.

2) The “restriction requirement” is also an unlawful taking prohibited by the U.S. Constitution, 5<sup>th</sup> Amendment. This is necessarily so as the following example will illustrate. Claims 1 and 11 are independent claims in Group I. The Examiner stated that Species A is Figure 4 and Species B is Figure 8. As required under M.P.E.P. §818.03(b), Applicant provisionally elected, with traverse, to pursue Species A. Applicant’s claim 1 (as well as other claims) read on Figure 4. Let us assume that Applicant obtains allowance of claim 1 and then wishes to file a divisional application concerning Species B. However, Claim 1 reads on Fig. 4. Accordingly, Applicants could ~~not~~ file a divisional application and obtain claims to cover their embodiments of Figure 8 because Claim 1 will not be allowed in the divisional application since the identical claim is in the parent patent. Thus, in this example, by being required to exclude the subject matter of non-Fig. 4 embodiments in the first patent application, Applicant’s rights to their Fig. 8 embodiment will have been extinguished and taken by the government.

3) The Manual of Patent Examining Procedure (MPEP) does not allow the restriction requirement imposed by the Examiner in this case. The MPEP requires that an Examiner must base a restriction requirement on the claims, not the figures in an application.

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<sup>3</sup> 35 U.S.C. §101: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

The statutory basis for restriction requirements refers to **claims**, not figures. "If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions." 35 U.S.C. §121.

The MPEP clearly requires an Examiner to base a restriction on the **claims**. There are many examples of this throughout Chapter 800, which governs restriction practice, and some of the most prominent are recited below.

"In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence." MPEP § 806.01.

"Where the **claims** of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction there between should never be required." MPEP § 806.03.

"Where an applicant files a divisional application claiming species **claimed** but not elected in the parent case . . . there should be no determination of whether or not the species **claimed** in the divisional is patentable over the species retained in the parent case since that determination was made before the requirement to restrict was made. . . .

"The Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. . . ." MPEP § 806.04(h).

The form Outline of Letter for Restriction requires the Examiner to, "List **claims** in each group." MPEP § 817 Outline of Letter (a)(2).

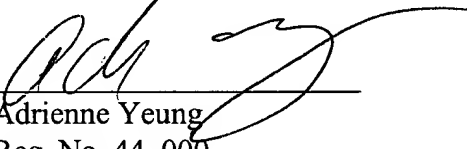
**Summary**

Accordingly, the Examiner's "restriction requirement" is without merit and violates Applicant's rights guaranteed under the United States Constitution, 5<sup>th</sup> Amendment<sup>4</sup> and under 35 U.S.C. §101. Since at least independent claims 1 and 11 read on the 2 "species" identified by the Examiner, the instant restriction requirement must be withdrawn.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this petition, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account 50-1698.

Respectfully submitted,  
THELEN REID & PRIEST LLP

Dated: February 2, 2004

  
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<sup>4</sup>"No person shall be... deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation."

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Total Number of Pages in This Submission	Application Number	09/843,496
	Filing Date	04/25/01
	First Named Inventor	Mark Ashby
	Art Unit	3724
	Examiner Name	Druan, Thomas J
Attorney Docket Number		034298-092

## ENCLOSURES (check all that apply)

☒ Fee Transmittal Form☒ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Response to Missing Parts/Incomplete Application☐ Response to Missing Parts under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☒ Petition☐ Petition to Convert to a Provisional Application☐ Power of Attorney, Revocation Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ After Allowance Communication to Group☐ Appeal Communication to Board of Appeals and Interferences☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s) (please identify below):

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name

Adrienne Young, Reg. No. 44,000

Signature

Date

February 2, 2004

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Signature

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February 2, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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